

### REMARKS

Claims 1, 3-8, and 10-20 are pending in the application and the same have been rejected. Claims 1, 3-8, and 10-20 remain in the application and are presented for review and further consideration by the Examiner.

The Examiner has rejected claims 1, 3-8, and 10-20 under 35 U.S.C. §103(a) as being unpatentable over McCurdy et al., U.S. Patent Application Publication No. 2002/0035697 A1, in view of Wade et al., U.S. Patent No. 5,552,776. (Final Examiner's Action, page 2, ¶ 3). In response to Applicants' arguments that Applicants' date of invention predates the effective date of McCurdy, the Examiner states that the declaration or exhibits are not clear enough to indicate definite conception of the invention as illustrated in Applicants' claim language. It is unclear from the Advisory action which elements of Applicants' claims that the evidence does not support conception. In the Final Office Action, the Examiner specifically identifies Applicants' claim language "a recorded unique device identification to uniquely identify" and suggests that the language is not supported by Applicants' exhibits. (Final Examiner's Action, page 4, ¶ 4).

Applicants respectfully disagree.

A second declaration from the Applicants is attached which more clearly recites the relationship between the claim language of Applicants' claims and the disclosure of Exhibit A.

It should now be clear that Applicants' exhibits and declarations together provided support for at least Applicants' independent claims. The support is very explicit and not vague or composed of general statements in broad terms. Since Applicants' exhibits and declarations support Applicants' claim language, they also indicate definite conception of the invention as illustrated in Applicants' claim language. Since Applicant's exhibits and declaration indicate definite conception of the invention and the exhibits predate the effective date of McCurdy, Applicants' date of invention predates the effective date of McCurdy. Since

Applicants' date of invention predates the effective date of McCurdy, McCurdy cannot be used as a basis for rejection for the present invention.

Furthermore, as the Examiner has agreed, the remaining reference, Wade, does not disclose each of the elements of the present invention, as claimed in Applicants' independent claims 1, 8, and 15.

The Examiner further notes in the Advisory Action that Applicants' declaration does not indicate diligence from a date prior to the date of reduction to practice of the McCurdy reference.

In response, Applicants have added additional statements in the enclosed declaration concerning their diligence in constructively reducing the invention to practice. It should now be clear that Applicants were diligent in constructively reducing their invention to practice from at least May 9, 2000 until their patent application was filed.

The Examiner also states that it is not clear whether the acts performed in as recited in the declaration were performed in this country.

In response, Applicants have added an additional statement in the enclosed declaration indicating that all activities related to the conception and constructive reduction to practice of this invention were carried out in this country.

In view of Applicants' arguments with respect to independent claims 1, 8, and 15 being allowable, Applicants respectfully submit that the remaining dependent claims are also allowable because they contain all of the limitations of their respective independent claims and further add structural and functional limitations.

The foregoing arguments are believed to be a complete response to the most recent Examiner's Action.

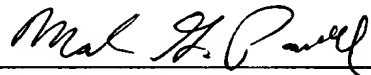
No new matter has been added.

It is respectfully submitted that there is no claim, teaching, motivation, or suggestion in any of the cited art, alone or in combination, to produce what Applicants claim.

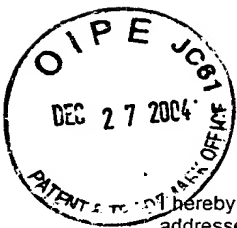
It is further submitted that the application defines patentable subject matter and that the claims are in a condition for allowance. Such allowance at an early date is respectfully requested.

Should any issues remain which would preclude the prompt disposition of this case, it is requested that the Examiner contact the undersigned practitioner by telephone.

Respectfully submitted,  
Donald J. Gathman,  
Burton H. Poppenga, and  
Susan M. Janz

By   
Mark G. Pannell  
Reg. No. 40,761

Date 12/20/2004  
(719) 260-7900



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450  
Date of Deposit: 12/20/2004  
Typed Name of Person Mailing Paper or Fee: Vickie L. Hensley  
Signature: Vickie L. Hensley

**PATENT APPLICATION**  
**ATTORNEY DOCKET NO. 10003904-1**

**IN THE**  
**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Inventor(s):** Donald J. Gathman, et al. **Confirmation No.:** 6315  
**Application No.:** 09/775,109 **Examiner:** Kindred, Alford W.  
**Filing Date:** 01/31/2001 **Group Art Unit:** 2172  
**Title:** Aggregating Device Collection Data

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**DECLARATION OF ATTORNEY UNDER 37 CFR 1.131**

I, Mark G. Pannell, declare as follows:

1. No later than June 22, 2000, I received a Request for Quote and Engagement Letter Agreement, from the Hewlett Packard legal department, to prepare and file a patent application based on Applicants' invention as disclosed in Exhibit A. Attached as Exhibit B is a copy of the Request for Quote and Engagement Letter Agreement, which I signed on June 22, 2000. At that time, I had a reasonable backlog of unrelated cases which I took up in chronological order and carried out expeditiously. No later than October 25, 2000, I began work on the patent application. On November 11, 2000, I sent a first draft of the patent application to the Applicants. The Applicants asked for revisions. On December 6, 2000 I sent a second draft of the application to the Applicants. The second draft of the application was approved by the Applicants no later than December 20, 2000. On December 20, 2000, I sent the approved draft to the legal department of Hewlett Packard for review. On January 29, 2001, I received a

Declaration and Power of Attorney signed by the Applicants and instructions to file the patent application. On January 31, 2001, I filed the patent application.

2. All activities related to the constructive reduction to practice of this invention were carried out in this country.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or any patent issuing thereon, declares that all statements made of our own knowledge are true; and all statements made on information and belief are believed to be true.

Mark G. Pannell

Mark G. Pannell

12/20/04

Date

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450  
Date of Deposit: 12/27/04  
Typed Name of Person Mailing Paper or Fee: Vickie L. Hensley  
Signature: Vickie L. Hensley



**PATENT APPLICATION  
ATTORNEY DOCKET NO. 10003904-1**

**IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

**Inventor(s):** Donald J. Gathman, et al.      **Confirmation No.:** 6315  
**Application No.:** 09/775,109      **Examiner:** Kindred, Alford W.  
**Filing Date:** 01/31/2001      **Group Art Unit:** 2172  
**Title:** Aggregating Device Collection Data

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**SECOND DECLARATION OF INVENTORS UNDER 37 CFR 1.131**

We, Donald J. Gathman, Burton H. Poppenga, and Susan M. Janz, declare as follows:

1. The present invention was conceived no later than May 9, 2000. We prepared drawings and a written disclosure of our invention as an internal invention disclosure (Exhibit A) on or before May 9, 2000. On May 10, 2000, we submitted the internal invention disclosure to the legal department of the company for which we are employed, Hewlett Packard, the assignee. Submitting an internal invention disclosure is the proper procedure in Hewlett Packard for beginning the process of applying for a patent. No later than October 25, 2000, we were contacted by an outside counsel patent attorney that had been assigned the case by the Hewlett Packard legal department. We worked with the patent attorney in preparing a patent application for our invention. On November 11, 2000, we receive a first draft of the patent application and asked for revisions. On December 6, 2000 we received a second draft of the application. We

approved the second draft of the application no later than December 20, 2000. On January 25, 2001, we signed the Declaration and Power of Attorney for the Patent Application.

2. With reference to the DECLARATION OF INVENTORS UNDER 37 CFR 1.131 filed May 27, 2004 and the Exhibit A filed therewith, Exhibit A illustrates the conception of the present invention as recited in the claims of our patent application. "Reading, from an input record" is shown on the page entitled Falcon Process Flow at the box with the wording, "Read Falcon record." The wording of the box clearly indicates that what is read is a record. That it is also an "input record" is inherent in that the record is read. Since the Falcon record is an input record, "reading from an input record is clearly conceived.

That from the input record is read "a recorded unique device identification to uniquely identify a device" is shown on the page entitled Flow 1A at the box with the wording, "Is Serial Number invalid, default, or Falcon duplicate?" It is apparent from the flow of the diagram that the serial number referred to in this box was read from the Falcon record, above, since there are no other boxes earlier in the flow from this one in which a serial number could be obtained. By its nature, a serial number is a unique device identification to uniquely identify a device.

That from the input record is also read "recorded device usage data for the device" is shown on the page entitled Flow 1A Continued at the box with the wording, "Is Falcon total\_page\_count value numeric?" "Falcon total\_page\_count" clearly refers to the Falcon record. Additionally, it is apparent from the flow of the diagram that the Falcon total\_page\_count referred to in this box was read from the Falcon record, above, since there are no other boxes earlier in the flow from this one in which a Falcon total\_page\_count could be obtained. By its nature, a total page count is device usage data for a device.

"Searching an index for an enduring unique device identification matching the recorded unique device identification" is shown on the page entitled Flow 1A at the boxes with the wording, "Search Items table for Serial Number and deleted\_item = No" and "Was device found?" These two boxes illustrate searching a table (found in the

database diagram of Exhibit A) for a match to the serial number from the Falcon record. The Items table is an index and a matching serial number in the Items table is an enduring unique device identification.

"Updating the index with the recorded device usage data" is shown on the page entitled Flow 1A Continued at the box with the wording "Update usage\_data.total\_page\_count". This illustrates updating the usage\_data (found in the database diagram of Exhibit A) with the Falcon total\_page\_count. The database, by its nature, is an index.

Together, the boxes of the flow chart and their sequence in the process flow chart together with the database diagram illustrate the present invention as claimed in our patent application. That the requisite means for accomplishing our invention and the interaction of the means is comprehended is shown by Exhibit A which illustrates a process flow, database relationships, and the interaction between them.

3. All activities related to the conception and constructive reduction to practice of this invention were carried out in this country.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or any patent issuing thereon, declares that all statements made of our own knowledge are true; and all statements made on information and belief are believed to be true.

  
\_\_\_\_\_  
Donald J. Gathman

12/20/2004  
Date

\_\_\_\_\_  
Burton H. Poppenga

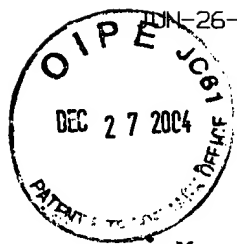
\_\_\_\_\_  
Date

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Susan M. Janz

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Date



**Request for Quote and Engagement Letter Agreement**

RE: Hewlett-Packard Docket No. 10003904-1

USSN:

M

- ☒ This is a request for a quote for the following services:
- ☐ This is a confirmation of your quote for the following services:

**PREPARE**

- ☐ Application ☒ **File with USPTO**
- ☐ Response ☐ Return to HP for filing
- ☐ Other \_\_\_\_\_

☒ **YOUR FINISHED PRODUCT TO HP SHOULD INCLUDE ALL ITEMS ON THE ENCLOSED CHECKLIST.**

**HP REQUIRED DATES:** \_\_\_\_\_ Date for Receipt by HP  
Nov. 15, 2000 Date to be Filed in PTO

**HP Attorneys of Record:** (to be included on the Declaration)

Customer Number 022879

**HP Primary Technical Contact:** Don Gathman

Telephone No.: (208) 396-6675 FAX No.:

HP Entity: DWS

Address: 11307 Chinden Blvd.  
Boise, Idaho 83714

**ADDITIONAL TERMS OR INSTRUCTIONS:**

\*\*\*On the DEC and POA, please list Lane R. Simmons as designate person for the USPTO contact regarding this application\*\*\*

Your quote should not include foreign claims or abstract as there will be NO foreign filing for this application.

**TOTAL PRICE:** \$4880 (including Formal drawings)

I agree to the terms of this Agreement including the additional terms above, pursuant to the HP Procedures for Outside Counsel revised **OCTOBER 15, 1999** a copy of which I have received and reviewed. This Agreement will not be binding on either party until signed by an authorized representative of HP.

**Hanes & Schutz**

**HEWLETT-PACKARD COMPANY**

By: Mark Pannell  
Mark Pannell

By: Steven R. Ormiston  
Steven R. Ormiston

Dated: 6/22/00

Dated: 6/22/00